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28. (Amended) A composition according to claim 1, further comprising at least one direct dye chosen from neutral, cationic, and anionic nitro dyes, cationic, and anionic azo dyes and cationic, and anionic anthraquinone dyes.

REMARKS

I. Status of the Claims

Claims 1-48 are pending in this application. Claim 28 has been amended to correct a typographical error, so no new matter has been added by this Amendment.

II. Allowable Subject Matter

Applicants thank the Office for indicating that claim 5 contains allowable subject matter. *See* Office Action at page 5.

III. Claim Objections

The Examiner objected to Claim 28 because the phrase "chosen from" appears twice. This is merely a typographical error, and Applicants have amended Claim 28 to correct it. Applicants therefore request the Examiner to withdraw this objection.

IV. Rejection for Obviousness-Type Double Patenting

Claims 1-48 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 53-68 of co-pending Application No. 09/836,600.

To advance prosecution, Applicants have filed herewith a Terminal Disclaimer over the co-pending application in accordance with M.P.E.P. § 804.02. Thus, Applicants request that the rejection be withdrawn.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

V. Rejection under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-4 and 6-48 as allegedly unpatentable over U.S. Patent No. 5,993,491 to Lim, in view of WO 99/17730 to de la Mettrie[1], U.S. Patent No. 5,948,121 to Aaslyng and further in view of U.S. Patent No. 6,398,821 to Dias. Applicants believe the references, taken separately or together, lack the requisite motivation to combine their teachings to achieve the present claimed invention and therefore traverse this rejection.

The Federal Circuit has held that there must be a "clear and particular" suggestion in the prior art to combine the teachings of cited references as pro[2]posed by the Examiner. *In re Dembiczak* 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). As explained by the Federal Circuit, "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *Id.* The Federal Circuit recently emphasized that the Patent Office must not only "assure that the requisite findings [of motivation] are made, based on the evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

The *Lee* decision holds that such a conclusory analysis "does not comport with either the legal requirements for determination of obviousness or with the requirement of the APA (Administrative Procedure Act) that the agency tribunal set forth the findings

[1] Equivalent to U.S. Pat. Number 6,228,129 B1

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

and explanations needed for "reasoned decision making." *Id.* at 1346. In the present case, the Examiner has not made any such explanations, but rather makes conclusory statements based on improper hindsight-based reconstruction of the present invention. The Examiner has not properly set forth the rationale on which he relies to support the assertion of obviousness. Specifically, he has not explained how one skilled in the art would have been motivated to combine the cited references.

The Examiner asserts that "[t]he instant claims differ from [Lim] by reciting a hair dyeing composition comprising dyeing ingredients such as enzymatic oxidizing system as oxidizing agents and direct dyes." Office Action at page 4. Then, in an effort to cure these deficiencies, the Examiner relies on de la Mettrie, Aasylng, and Dias, as analogous art, merely on the basis that their disclosures "would be similarly useful and applicable to the analogous composition taught by Lim." *Id.* at page 5. Applicants respectfully disagree, and submit that the Examiner's analysis is misplaced.

Present claim 1, for example, is directed to a composition comprising at least one enzymatic oxidizing system comprising at least one enzyme chosen from 2-electron and 4-electron oxidoreductases and peroxidases; and at least one oxidation dye precursor chosen from 1-(4-aminophenyl) pyrrolidines of formula 1 and acid addition salts thereof.

Lim, on the other hand, teaches 1-(4-aminophenyl) pyrrolidines for use in oxidative hair dyes, but does not disclose the use of an enzymatic oxidizing system. Specifically, Lim provides oxidative hair dye compositions and methods for the "oxidative coloration of hair comprising compounds of the class of 1-4-(aminophenyl)-2-pyrrolidinemethanols . . . as primary intermediates in compositions comprising such primary dye intermediates as well as coupling agents, oxidizing agents and other

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

adjuvant substances." Col. 2, lines 33-40. Lim, however, does not mention or even suggest the incorporation of an enzymatic oxidizing system, as employed in the present invention. Moreover, the Office has not shown that there would be any desire to modify the invention of Lim. *See* M.P.E.P. § 2143.01, citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990) ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."). Further, as taught by Lim, the compositions and methods of the invention lead to the preparation of "stable oxidative hair dyes that result in long-lasting and true colors which are different from colors produced by similar primary intermediates." Col. 1, lines 8-11. As such, Applicants respectfully submit that there would not be a desire to modify Lim, and thus the rejection should be withdrawn for this reason alone.

The de la Mettrie reference does not remedy Lim's deficiencies. It teaches the use of enzymatic oxidizing systems, but not in connection with 1-(4-aminophenyl) pyrrolidines, or any pyrrolidines at all. In particular, de la Mettrie relates to oxidation dyeing with at least one oxidation base, at least one cationic direct dye, and at least one enzyme. *See* col. 1, lines 5-12. The combination of the specific components of the invention leads to optimum results. Specifically, the combination results in dyes "leading to intense and chromatic colorations, without giving rise to any significant degradation of the keratin fibres, and which are relatively unselective and show good resistance to the various attacking factors which hair may be subjected." *See* col. 2, lines 7-15. Applicants assert that de la Mettrie discloses many types of cationic direct dyes that may be used in its compositions, but it does not teach or suggest combining

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

any of the compounds with pyrrolidines, let alone 1-4-(aminophenyl) pyrrolidines. *See* col. 2, lines 7-15. Thus, the rejection should be withdrawn for this reason as well.

Applicants also point out that de la Mettrie discloses that the nature of the oxidation base used in its compositions is not even a critical factor. *See* col. 3, lines 9-13. For example, *inter alia*, de la Mettrie discloses that para-phenylenediamines may be used as oxidation bases. *See id*. By contrast, the present invention demonstrates that the selection of the oxidation base is essential to the claimed invention. For instance, Examples 1 and 2 on pages 68-71 of the instant specification demonstrate that the selection of an addition acid of 1-4-(aminophenyl) pyrrolidine, instead of a para-phenylenediamine, as an oxidation base, results in a hair dye that is more intense in color. Thus, mixing and matching ingredients from different dye compositions in different references, without considering each reference as a whole, is not as easy as the Examiner appears to think. The unpredictability of combinations of various hair-dye ingredients makes it inappropriate for the Examiner to assume obviousness based entirely on his assessment that the enzymatic oxidation systems of the secondary references would be similarly useful and applicable in Lim.

Similarly, Aaslyng and Dias teach the use of enzymatic oxidizing systems, but also not with the use of pyrrolidines, let alone 1-(4-aminophenyl) pyrrolidines. Thus, there is no evidence in the record that supports the Examiner's selectively choosing teachings from de la Mettrie, Aaslyng, and Dias to supplement or modify the dye composition of Lim. *See In re Zurko*, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001) (finding that unless there is "substantial evidence" found in the record to support the factual determinations central to the issue of patentability, the rejection is

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

improper and should be withdrawn). As there is no suggestion, other than Applicants' disclosure, to modify Lim, a prima facie case of obviousness has not been made. Accordingly, the rejection should be withdrawn for this additional reason.

VII. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 11, 2003

By: Thalia V. Warnement
Thalia V. Warnement
Reg. No. 39,064

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

APPENDIX: Version With Markings To Show Changes Made

Pursuant to 37 CFR 1.121(c)(1)(ii)

In the Claims:

28. A composition according to claim 1, further comprising at least one direct dye [chosen from] chosen from neutral, cationic, and anionic nitro dyes, cationic, and anionic azo dyes and cationic, and anionic anthraquinone dyes.

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GARRETT &
DUNNER LLP

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